

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re H. E. Butt Grocery Company

Serial No. 75932206

Kirt S. O'Neill of Akin, Gump, Strauss, Hauer & Feld,
L.L.P. for H. E. Butt Grocery Company.

Desmona Mizelle, Trademark Examining Attorney, Law Office
110 (Chris Pedersen, Managing Attorney).

Before Simms, Cissel and Seeherman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 28, 2000, applicant, a Texas corporation,
filed the above-referenced application to register the mark
"BIG COOL BAG" on the Principal Register for "insulated
tote bags," in Class 16. The basis for filing the
application was applicant's assertion that it had used the

mark in connection with the specified goods in interstate commerce at least as early as February 28, 2000.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, as used in connection with insulated tote bags, so resembles the mark shown below

COOLBAG

which is registered¹ for "thermal insulated containers and tote bags for food or beverage," in Class 21, that confusion is likely. The Examining Attorney also refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark is merely descriptive of applicant's goods, and required amendment to the identification-of-goods clause to clarify the nature of the goods.

Responsive to the Office Action, applicant amended the application to identify its goods as "thermal insulated tote bags for food in International Class 21," and disclaimed the exclusive right to use the words "big" and "bag," apart from the mark as shown.

¹ Reg. No. 2,273,405, issued on the Principal Register to Coolbag Handels GmbH, a corporation of Switzerland, on August 31, 1999.

Taking the position that the word "cool" in its mark does not describe, but rather only suggests, the function of keeping food cold or frozen, applicant argued that "... while COOL may be suggestive of a function of the bag in keeping frozen foods 'cold' it also presents a double entendre in the context of the overall mark BIG COOL BAG as being a 'hip' product." Citing *Ex Parte Barker*, 92 USPQ 218, 219 (Comm'r Pats 1952) for the proposition that even where the individual words making up a mark are descriptive, the existence of a double entendre can result in sufficient distinctiveness to support a registration, applicant contended that the refusal in the case at hand based on descriptiveness was not appropriate in view of the double entendre created by the use of the word "COOL" in its mark.

Applicant argued against the refusal under Section 2(d) of the Act based on the fact that applicant's mark does not include any of the design elements shown in the cited registered mark and the fact that the word "BIG," which appears in applicant's mark, is not part of the cited registered mark. Applicant took the position that its three-word mark "BIG COOL BAG" incorporates "alliterative and design features and double entendres not present in the cited mark."

The Examining Attorney accepted applicant's amendment to the identification-of-goods clause and apparently withdrew the refusal to register based on mere descriptiveness under Section 2(e)(1) of the Act, but maintained and made final the refusal based on likelihood of confusion under Section 2(d) of the Act. She pointed to the fact that the products specified in the application are virtually identical to those listed in the cited registration and concluded that the marks create similar commercial impressions.

On February 10, 2003, applicant filed a Notice of Appeal, a request for reconsideration (to which were attached a number of exhibits which applicant argued showed widespread use of "cool bag" or its equivalent descriptively with respect to thermal insulated tote bags) and a motion to consolidate this application with application Ser. No. 75930775.

The appeal was instituted, but action on it was suspended and the application was remanded to the Examining Attorney to address applicant's request for reconsideration. Action on the motion to consolidate was deferred.

The Examining Attorney reconsidered the refusal to register based on the arguments and the evidence submitted

by applicant, but maintained that the refusal to register is appropriate. Both applicant and the Examining Attorney filed appeal briefs, but applicant neither filed a reply brief nor requested an oral hearing before the Board.

Prior to discussing our resolution of this appeal on its merits, we first must deny applicant's request for consolidation with application Ser. No. 75930775. Although the issues with regard to that application are similar in some respects to those presented by the case at hand, the mark applicant seeks to register by means of that application is not the same as the one in the instant case. Because of this, the issues and supporting arguments are not the same. Further, that application is not ripe for appeal at this time. Accordingly, combining the two applications for purposes of resolving both with this appeal is not appropriate.

We thus turn to the issue presented by the instant case, whether Section 2(d) of the Lanham Act precludes registration to applicant of the mark "BIG COOL BAG" in view of the prior registration of the mark "COOLBAG" in the design format shown above. We hold that the refusal to register is proper because the marks create very similar commercial impressions and the goods specified in the

application and the cited registration, respectively, are identical.

When they are considered in their entirety in connection with these identical products, the two marks create similar commercial impressions. It is well settled that one element or feature of the mark can have more significance in creating a commercial impression.

Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976). In view of the descriptive (and hence disclaimed) terms "BIG" and "BAG," the dominant portion of applicant's mark is clearly the word "COOL," which is at the very least suggestive in connection with insulated bags. The registered mark combines the same suggestive word with the same generic term, "BAG." Applicant has essentially appropriated the registered mark and added to it only the term "BIG." The addition of this disclaimed, descriptive word is insufficient to overcome the similarities between these two marks. A prospective purchaser of the insulated bags sold under the mark applicant seeks to register would be likely, if he or she were familiar with the use of the cited registered mark in connection with the same goods, to assume that a bag bearing the "BIG COOL BAG" designation is simply a larger model or version of the "COOLBAG" with which he or she is

familiar. Notwithstanding applicant's arguments to the contrary, whatever double entendre applicant's mark creates is the same as that which the cited registered mark engenders.

A similar flaw exists with respect to the argument applicant made in its request for reconsideration. There, applicant submitted evidence showing that the term "cool bag" and several variations of it have been used by others in connection with insulated bags. Based on this evidence, applicant contends that "COOL BAG" is descriptive of these products, that it is therefore weak in source-identifying significance, and that this weakness supports the conclusion that confusion between applicant's mark and the cited registered mark is unlikely.

To the extent that applicant is arguing that the registered mark is merely descriptive, this would be an impermissible collateral attack on the cited registration. To the extent that applicant is asserting that the cited registration is entitled to only a limited scope of protection, we find that protection would extend to the use on identical goods of the extremely similar mark "BIG COOL BAG," with the only difference being the addition of the descriptive word "BIG" to the registered mark.

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DECISION: The refusal to register under Section 2(d)
of the Act is affirmed.